

Remarks and Arguments

Applicants have carefully considered the Office Action dated May 29, 2007 and the references cited therein. Applicants respectfully request reexamination and reconsideration of the application.

Claims 1-22 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of US Patent 6,965,912, by the same inventors. In addition, Claims 1-22 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of the copending patent application publication number 2004/0205138A1 and over claims 1-24 of the copending patent application publication number 2006/0036681A1. Notwithstanding the foregoing, Applicants respectfully request that the nonstatutory obviousness-type double patenting rejections be held in abeyance until an indication of allowable subject matter or the issuance of a US patent from copending patent application Publication No. 2004/0205138A1 or Publication Number 2006/0036681A1.

The Examiner contends that claims 3-5 are non-statutory because these claims are directed to non-statutory subject matter. Claim 3 has been amended and now recites “a *tangible* computer usable medium” (claim 3, lines 2-3). This amendment has not been made to distinguish over any reference of record and no narrowing of any corresponding equivalents to which the amended limitation(s) or claim(s) is/are entitled is intended by these amendments. As such claims 3-5 are believed to comply with all sections of 35 USC section 101.

Claims 1-22 have been rejected under 35 U.S.C. 102(b) as being anticipated by Small, U.S. Patent No. 5,513,117, hereafter Small ‘117, already of record. In the prior response, Applicants unintentionally miscalculated difference between the priority date of the Small ‘117 reference and that of the subject application. Applicants apologize for any confusion that the submitted traversal arguments may have caused.

Before addressing the Examiner’s rejections, Applicants request that Examiner consider the following. The present invention discloses a method, system, computer program product, data structure for enabling users to select over a computer network any of a plurality of gifts from a vendor web site and to designate a recipient. The user

can then access, from the same site or a different site, a compilation of customizable cards. The user can then independently select any of the cards and personalize the selected card through various modifications. The selected, personalized card is printed at the location where the gift that has been ordered on line is physically located. The personalized card and corresponding gift are matched and combined as a single parcel for shipment to the designated recipient. In the present invention, the gifts are not just gift certificates, but may be physical entities of different types. Further, the card and gift combination is not predetermined, i.e. the selected gift does not predefine or limit the selection of cards, nor does the selected card predefine or limit the selection of gift(s). Accordingly, the present invention allows any number of independently selectable, cards to be customizable and matched with any number of selectable gifts, without predetermined limitations, and for the customized card and gift(s) to be sent together as a single combined entity to the designated recipient. As set forth in the subject application, the readable data printed on the personalized greeting card may function as a shipping label in the fulfillment environment to match a gift with a card. Alternatively, such readable data may be utilized to generate an intermediate label, such as a pick ticket, useable to help match the printed greeting card with another item in the fulfillment warehouse. In this matter, the personalized greeting card itself becomes a mechanism for facilitating the matching of a gift with the card.

In contrast, the Small reference, on which the current set of rejections are based, does not provide a personalizable card that can be selected *independent* of any of a plurality of items ordered on line. Small discloses a kiosk-like, automated vending apparatus for simultaneously dispensing personalized greeting cards and *electronically* vendable gifts (Small, column 2, lines 30-33). Such gifts are limited to gifts that can be evidenced by an electronically generated personalized printout combined with or printed directly on a personalized card (Small, column 2, lines 55-59). Small does not disclose a system which is capable of simultaneously delivering a personalized greeting card with a tangible gift, since there is no technique disclosed for matching and bundling of the personalized card and the tangible gift.

Notwithstanding, the Examiner's assertions regarding claims 2 or 3, none of the cited sections or the rest of the Small specification disclose the use of generating from

the readable data printed *on the greeting card* either a *shipping label* or a *packing list*. The alleged disclosure within the Small must be enabling to properly anticipate the subject matter recited in applicants claims. A prior art reference must contain an enabling disclosure. MPEP 2121.01 states in relevant part: "[i]n determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'... ." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003)."

Notwithstanding the foregoing claim 1 has been amended to recite "generating from the readable data printed on the greeting card a shipping label" (claim 1, lines 7-8). Although figure 6 of Small illustrates a menu selection 83 for enabling printing and mailing of the card 81, there is no teaching disclosure or suggestion that a shipping label or packaging label is generated from any information on the actual card itself, as claimed in a subject invention. The Examiner will further note that item 175 of figure 10 in Small is a UPC code, and does not appear useful for generating a shipping label. Accordingly, Applicants respectfully assert a claim 1 is not anticipated by Small. Claim 2 has been canceled, without prejudice.

Claim 3 is amended to include the limitations of claim 4 and is likewise believed not anticipated by Small for reasoning similar to that set forth with reference to claim one above. For similar reasoning similar to that stated above, that is, the Examiner has not shown where Small discloses reference data or in a card that is useful for generating a packaging label. Accordingly, Applicants respectfully assert a claim 3 is not anticipated by Small. Claim 4 has been canceled, without prejudice.

Claim 6 has been amended to recite "reading the reference data from the greeting card" and "using the read data to access in memory data defining any of a greeting card destination address, and lot number identifying a gift with which the personalized greeting card will be shipped" (claim 6, lines 5-8). Again, the Examiner has

not shown where Small discloses using the read data to access in memory data defining any of a greeting card destination address, and lot number identifying a gift with which the personalized greeting card will be shipped. Accordingly, Applicants respectfully assert a claim 6 and its respective dependent claims are not anticipated by Small.

Claim 11 is amended and now recites "program logic configured to read the reference data from the card and generate a label therefrom" (Claim 17, lines 8-9). Again, the Examiner has not shown where Small discloses that a label is generated from any information on the actual card itself, as claimed in a subject invention.

Claim 16 is amended and now recites "printing readable data on one of the *n* panels of the greeting card, the readable data comprising data identifying one of a product with which the greeting card will be matched, and a destination shipping address" (Claim 16, lines 7-9). Again, the Examiner has not shown where Small discloses printing data on a panel of the card identifying either a product with which the greeting card will be matched or a destination shipping address.

Claim 17 is amended to include the limitations of claim 18 and now recites "maintaining, in a memory, reference data representing one of data identifying a product with which the personalized document will be matched, and a destination shipping address " (Claim 17, lines 8-10). Again, the Examiner has not shown where Small discloses maintaining data in a memory which represents a product with which the personalized document will be matched, *or*, a destination shipping address. Accordingly, Applicants respectfully assert a claim 17 and its respective dependent claims are not anticipated by Small. Claim 18 has been canceled, without prejudice.

Applicants believe the claims are in allowable condition. A notice of allowance for this application is solicited earnestly. If the Examiner has any further questions regarding this amendment, he is invited to call Applicants' attorney at the number listed below. The Examiner is hereby authorized to charge any fees or credit any balances under 37 CFR §1.17, and 1.16 to Deposit Account No. 02-3038.

Respectfully submitted,

/Bruce D. Jobse/

Date: 2007-10-29

Bruce D. Jobse, Esq. Reg. No. 33,518
Rissman Jobse Hendricks & Oliverio, LLP
Customer Number 021127
Tel: (617) 367-4600 Fax: (617) 367-4656